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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/735,519
Filing Date: December 12, 2003
Appellant(s): KIM ET AL.

Stephen C. Jensen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/7/09 appealing from the Office action mailed 6/9/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-23, 35-48, 50-60 and 62-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. MPEP 2173.05(i). In this case the language "using distinguishing between each of the captured, non-captured and fusion/pseudofusion responses using the single cardiac signal **without** using any other cardiac signal following the pacing pulse" in combination with the other elements in claims 1, 15, 35, 39, 52, 57, 59, 62 are not disclosed in the original disclosure and thus fails to comply with the written description requirement. The figures and specification do not disclose using any other cardiac signal sensed following the pacing pulse. This therefore, does not mean that they inherently had possession of an invention where they did not include using other cardiac signals following the pacing pulse. Applicants can only define over the prior art with limitations that they had possession of at the time of invention. Since the negative limitation is not expressly set forth in the specification, it is considered new matter.

(10) Response to Argument

Rejections under 35 U.S.C. 112, first paragraph

Appellant argues that the disputed language, “by the sensed cardiac signal without using any other cardiac signal sensed following the pacing pulse” is shown in the written description as no other signals are described in the written description. The mere absence of other signals in the specification does not provide the Appellant the basis to claim that system does not use other signals. To emphasize the point, the claim states, “... classifying the cardiac response...”, theoretically the prior art classifies the response using a beat to beat comparison, but the Appellant's specification did not disclose using a beat to beat comparison. Could they include the phrase classifying by any means other than beat to beat comparison. The Appellants specification does not state if it does or if it does not do beat by beat comparison. Should they be able to choose during prosecution what is or is not covered by the phrase “classifying the cardiac beat”? By excluding elements that were absent in the specification it gives the Appellant the power to exclude certain elements and thus further implies the permissible inclusion of all other elements not so expressly excluded. See *Ex parte Grasselli, et al.*, 231 USPQ 395 (Bd. Pat. App. & Int. 1983). So by excluding beat to beat comparison the negative limitation opens up the opportunity to include all other types of classification including types of classifications not disclosed in the reference.

In this case the claim states, “using the sensed cardiac signal without using any other cardiac signal sensed following the pacing pulse”. The specification is silent as to the system using or not using any other signal following the pacing pulse. The

Appellant argues that the flow charts show that the system uses one signal. What is absent from the flow charts and the remaining parts of the written description is a description of using only a single signal **without** using any other signals. The Appellant argues that written description requirement merely stipulates that the disclosure, "must convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. " *Crown Operations International v. Solutia Inc.*, 289 F.3d 1367, 1376 (Fed. Cir. 2002). The Appellant then argues that the disclosure shows one signal thus it inherently meant that it uses only that single signal. But the specification is silent as to using or not using other signals. The Applicant could just as easily argue that the specification includes other signals as they could argue that it doesn't. When the specification is silent regarding a limitation, there is no support for including or excluding that limitation in the claims. By allowing the Applicant to selectively exclude limitations not disclosed in the specification, gives the Applicant free reign to claim anything by exclusion. For example, if the Examiner found only prior art that used cardiac and pressure pulses to classify the cardiac response, the applicant would equally not be entitled to claim "without using a pressure pulse" to classify the cardiac response since applicant can not pick and choose what they wish to discount from the prior art and/or since this would then allow the applicant to have a claimed opened ended invention that could USE another cardiac signal for the classification (which is what the applicant has said is not in the disclosure). For the reasons above, there is no support for excluding other signals and therefore the rejection under 35 U.S.C. 112, first paragraph should stand.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Rex Holmes

/Rex Holmes/

Examiner, Art Unit 3762

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